

**REMARKS**

**The amendments overcome the indefiniteness objections under  
35 U.S.C. § 112, second paragraph, to dependent claim 13 and  
independent claims 18 and 21.**

**Claim 21**

The Office Action stated (p. 3) that claim 21 appeared to claim the seat back as a part of the invention. As discussed in applicant's May 19, 2004 telephone interview with examiner Milton Nelson, Jr. (the "May 19, 2004 Interview"), claim 21, in the subsection b(1), has been amended from "extending far enough outward from said seat back" to "adapted for extending far enough outward from said seat back[.]" Subsection b(2) has similarly been changed: "when used in combination with said seat back, rests substantially against the plane of said front surface of said seat back."

The Office Action also stated (p. 3) that in claim 21 "the surface opposite from said base portion" lacked proper antecedent basis. The phrase "having two opposite surfaces" for the head-support portion is inserted to remedy this problem, as discussed in the May 19, 2004 Interview.

**Claim 13**

The Office Action (p. 3) objected to claim 13 on the basis that it was unclear if "a means for wrapping" was the same structure as the "means for wrapping" set forth in claim 21, from which claim 13 depends. The word "said" replaces "a" to make clear that this is the same structure. Similarly, the Office Action (p. 3) objected to claim 13 on the basis that it was unclear whether "said back of said seat back" is intended to be the same as the

“rear surface” of claim 21. Claim 13 is amended to use the phrase “said rear surface” to make the meaning clear.

### **Claim 18**

Claim 18 was objected to on the same basis as claim 21, regarding a lack of clarity as to whether the seat back was a part of the invention. (Office Action at pp. 2–3.) Applicant has therefore submitted amendments similar to those for claim 21. The amendments replace “which extends far enough outward from said seat back” to “which is adapted for extending far enough outward from said seat back[.]” The Office Action also stated (p. 3) that “said user’s” in claim 18 lacked proper antecedent basis. Applicant has amended the claim to state “a user’s[.]” Further, applicant has submitted amendments to claim 18 analogous to those made in response to objections found in the Office Action to claim 13. In that vein, claim 18 is amended to specify a seat back “having front and rear surfaces” and to specify that the base portion rests against “said front surface” of the seat back and to state that the user’s head may rest against “the plane of said front surface of said seat back” rather than “the plane of the front of said seat back.” Further, the claim is amended to specify that the “means for wrapping” are around “said rear surface” rather than “the back” of the seat back.

In view of the foregoing, the applicant submits that claims 12–16 and 18–21, as amended, are allowable under the second paragraph of 35 U.S.C. § 112. Applicant therefore respectfully solicits reconsideration and allowance thereof.

**The obviousness objection under 35 U.S.C. § 103(a) is overcome because the two references cited cannot be combined to yield applicant's invention, and because the proposed amendment to claim 21 renders it patently distinguishable over these references.**

The Office Action stated that Dickey (4,619,483) "shows all claimed features of the instant invention with the exception of the means for wrapping around the front and rear surfaces of the seat back[.]" And the Office Action stated that secondary reference Franzen (5,685,613) "conventionally teaches configuring a support with a means for wrapping ...." The Office Action concluded that it would be obvious to a person with ordinary skill in the art to modify Dickey's device in view of Franzen's teachings.

Applicant has amended claim 21 and submits new argumentation on this issue. Thus, applicant respectfully requests reconsideration of this conclusion based on the following:

- It is not possible to combine Dickey and Franzen to yield applicant's invention as claimed in the amended claim 21. An essential part is missing, and applicant's invention uses an entirely different principle of operation.
- The novel physical features of applicant's invention produce new and unexpected results; hence, applicant's invention is nonobvious and patentable over these references.
- There is no justification, in Dickey and Franzen, or in any other prior art, which suggests that these reference should be combined in the manner proposed.

**Combining Dickey with Franzen does not yield the instant invention.**

As applicant discussed in the May 19, 2004 Interview, combining Dickey with Franzen does not yield the invention of claim 21. There is an important part missing: applicant's base portion. Neither Dickey nor Franzen discloses applicant's base portion. Without applicant's base portion, Dickey's headrest and the shoulder support it is mounted on—when combined with Franzen's straps—will flop over under the weight of a person's head; that is, the headrest will yield obliquely.

It is important to note that although the Office Action equated applicant's base portion with Dickey's shoulder support, the two structures are entirely different. Dickey's shoulder support 20 lies against the side of the chair and extends outward in the direction faced by a person sitting in the chair. (See, e.g., Dickey, FIGS. 4, 5, & 6.) Applicant's base portion lies flat against the front surface of the seat back. In this way, applicant's invention, as defined in claim 21, can withstand the lateral pressure of the user's head despite being supported only by straps. Dickey's headrest, were it attached to the chair using straps, cannot do this.

**Applicant's invention's novel features represent a leap forward, producing new and unexpected results.**

Indeed, Dickey recognized that something must prevent the headrest and shoulder support both from oblique yielding when lateral pressure is applied by the user. However, Dickey teaches away from the solution embodied by applicant's invention. Dickey's device uses the arm of the chair to prevent oblique yielding. This is possible because Dickey's shoulder support, lying against the side of the chair, extends all the way down to the seat bottom, below the level of the arm. (See, e.g., Dickey, FIGS. 4 & 5.)

[T]he outward extending orientation of the shoulder support must be maintained. ... [T]his is accomplished by the depending portion 36 of the rigid support of the shoulder arrangement extending within the respective arm.

When weight is applied to the shoulder support, the depending portion abuts the side arm to prevent further outward swinging of the shoulder support.

(Dickey, col. 6, lines 2–9.)

Nothing in either Dickey or Franzen suggests how prevent oblique yielding without relying upon the rigid arm of the chair and a long, depending shoulder support to which the headrest is attached, in order to reach below the arm of the chair. By contrast, applicant's invention is entirely different, yielding unappreciated advantages over Dickey's device. Applicant's invention does not need a chair with arms. It does not need a long shoulder support descending to the seat bottom. It does not need an accessible, vertically straight side of the seat back. Instead, applicant's invention in claim 21 prevents oblique yielding of the headrest by the cooperation of the straps and the base portion lying flat against the seat back. This is an entirely different principle of operation from the cited references.

Structured in this way—with the base portion lying flat against the seat back and the head-supporting portion between the user's head and the base portion—the weight of the user's head actually reinforces the positioning of the device on the seat back, since the base portion cannot push through the surface of the seat back. Thus, applicant's approach represents a substantial leap forward, yielding unexpected beneficial results.

**There is no justification for combining Dickey and Franzen in the manner proposed, and the proposal of such a combination does not meet the legal standard for obviousness.**

Even assuming that a combination of Dickey and Franzen was physically workable and that it yielded applicant's invention—neither of which are the case—the proposed combination of Dickey and Franzen still does not render the invention of claim 21 legally obvious.

It is well established that in order for prior art references to be validly combined for rejecting a claim under 35 U.S.C. § 103, the references themselves, or some other prior art, must suggest such a combination. “[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantages to be derived from combining their teachings.” In re Sernaker, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983).

“Something in the prior art must suggest the desirability and thus the obviousness of making the combination.” Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). The suggestion of combining references cannot come from the patent application itself. See Orthopedic Equipment Co. v. U.S., 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983) (“It is wrong to use the patents in suit as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit ...”).

Franzen's teaching of the use of straps to hold the orthopedic pillow to the seat back is indeed “conventional[.]” (Office Action at p. 4.) This conventional use of straps permits holding something against the seat back where there will be no lateral force trying to dislodge it. This is not surprising, since Franzen's device is to correct hyperkyphosis—a front-to-back

deformity of the spine, not a lateral curvature (*e.g.*, scoliosis). Thus Franzen did not confront the problem of using straps to hold a headrest in place under lateral pressure, and the Franzen reference does not teach a way to secure such placement under lateral pressure using straps.

Applicant's use of straps, on the other hand, is not conventional at all, but is revolutionary, because it provides a means for the strapped assembly to resist lateral pressure. To achieve this, applicant's base portion is a necessary ingredient—the ingredient missing from either Dickey or Franzen.

There is no reason given in the Office Action for why it would be obvious to combine Dickey and Franzen in the manner proposed except that “[s]uch a modification enhances selective securement of the device to a supporting object.” (Office Action at p. 5.) Applicant respectfully submits that this reason is not legally sufficient to establish obviousness. This is especially the case here, where applicant's invention has a novel structure that offers unappreciated advantages and utilizes an entirely different principle of operation.

Thus, applicant respectfully submits that claim 21—the principle independent claim—is patentable over Dickey and Franzen.

In the Office Action, the examiner stated (p. 6) that the argumentation submitted with the prior Amendment B (mailed October 6, 2003) was “more limiting than the claim language.” For the avoidance of any doubt in this regard, that the arguments submitted in the instant amendment could be construed as being more limiting than the claim language, claim 21 has been amended to read “a rigid base portion to rest against said front surface of said seat back” rather than “against said seat back.” (Emphasis added.) This amendment clearly distinguishes applicant's invention from Dickey's device, wherein the shoulder

support is "connected to a side of the [seat] back and extends outwardly of the back in the general direction of a corresponding side arm." (Dickey, col. 1, lines 54–56.)

**As claims dependent from claim 21, claims 13 and 16 are not obvious.**

Applicant's claims 13 and 16 are dependent claims of claim 21. Claim 13 specifies the use of two straps being attachable with length-adjustable buckles. Claim 16 specifies a right-angle orientation of the base portion and the head-support portion. Both of these dependent claims incorporate the subject matter of independent claim 21 and are, therefore, *a fortiori* patentable over Dickey. Further, the right-angle orientation of the base portion and the head-support portion is missing from the Dickey reference. Although there is a right angle shown in Dickey's device, where the head-support portion extends horizontally across the seat back and the base portion extends vertically downward at a right angle (Office Action at p. 7), this is different from the right angle in applicant's device, in which the base portion, lying flat against the seat back, is engaged at a right angle with the head-support portion, which is extending outward from the front surface of the seat back.

In view of the foregoing reasons, applicant respectfully solicits reconsideration and allowance of claims 21, 13 and 16.

**Enablement objections under 35 U.S.C. § 112, first paragraph, and drawing objections under 37 CFR 1.83(a) with regard to the inflatable embodiments, (claims 17 through 20) are overcome.**

The Office Action objected to claims 17–20 under 35 U.S.C. § 112, first paragraph.

Claim 17 has been cancelled. Claim 18 has been amended so as to be allowable, and so as to make the claims depending from it allowable as well.



The Office Action objected to independent claim 18 on the grounds that it was “unclear how an inflatable structure forms when inflated, a rigid base portion, and includes a rigid head-support portion.” (Office Action at p. 2.) As discussed in the May 19, 2004 Interview, the problem seems to stem from the use of the word “rigid.” Examiner appears to construe “rigid” to be hard and unyielding, which would not describe, for instance, a rubber bladder inflated with air. Applicant did not intend the term “rigid” to be read in such a narrow sense of being inflexible or inelastic. Thus, for the avoidance of confusion, applicant has amended claim 18 to reference a “firm” base portion and “firm” head-support portion. The specification has not been amended, as it does not use the word “rigid” to describe the inflatable embodiments. Applicant respectfully submits this puts claim 18 in condition for allowance, obviating the 35 U.S.C. § 112, first paragraph, and 37 CFR 1.83(a) objections.

Additionally, the Office Action objected to claims 19 and 20 as indefinite as the depend upon claim 18. Thus, applicant submits respectfully that the amendment to claim 18 will remedy the objection to claims 19 and 20.

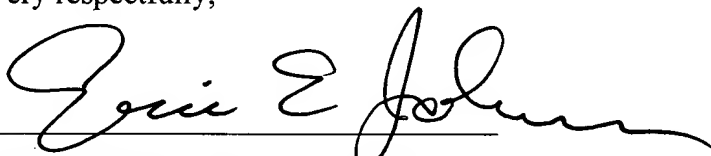
The Office Action also objected to the drawings under 37 CFR 1.83(a) on the grounds that the “rigid head-support and base portions” were not shown. Applicant respectfully submits that the above described amendments, removing the reference to “rigid,” will similarly remedy this objection.

Thus, applicant respectfully submits that the drawings and specification are sufficient to enable a person skilled in the art to make and use the invention.

**CONCLUSION**

For all the reasons given above, and on the basis of the amended and claims, applicant respectfully submits that the specification is complete, that the claims are in compliance with 35 U.S.C. § 112, and that the claims define patentable subject matter under 35 U.S.C. § 103. Accordingly, the applicant submits that this application is now in full condition for allowance, which action applicant respectfully solicits.

Very respectfully,

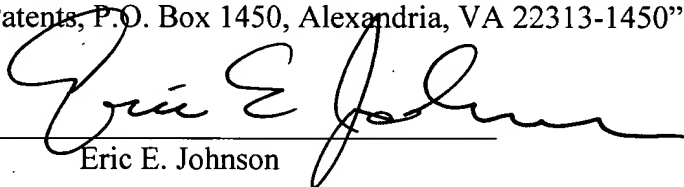


Eric E. Johnson, Applicant Pro Se

6142 Blackburn Ave.  
Los Angeles, CA 90036  
(323) 571-9773

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Eric E. Johnson